

REMARKS

Applicants thank Examiner Kruer for his courteous and congenial telephone interview with Applicants' representative on July 13.

Claims 1-6 and 8-13 are pending in the present application.

Claims 1 and 6 were amended and claims 12-13 were added to more particularly point out and clearly define the invention.

Claim 7 was canceled because the subject matter of the claim was incorporated into claim 6.

Claims 1-3 were rejected under 35 U.S.C. § 112, second paragraph.

Claim 1 has been amended by deleting the terms "metal element" and substituting the expression "metal, metal alloy, metal compound, or mixtures thereof". Support for this amendment is in the substitute specification at page 8, line 3 to page 9, line 12.

The Office Action's allegation that the claim fails to state a ratio is incorrect. The expression " 10^{12} - 10^{17} ($1/\square\cdot\text{cm}$)" is a ratio. The expression is a ratio of surface resistance of resin composite material/ resistivity of the component containing the metal, metal alloy or metal compound. Surface resistance of the resin composite material = Ω/\square , and resistivity of the component containing the metal, metal alloy or metal compound = $\Omega\cdot\text{cm}$. Surface resistance of resin composite material/resistivity of the component containing the metal, metal alloy, or metal compound = $\Omega/\square/\Omega\cdot\text{cm} = 1/\square\cdot\text{cm}$. Support in the substitute specification is at page 6, lines 1-7. Accordingly, the claim does recite a ratio.

Further, the units in the claim are not indefinite. The expression $1/\square\cdot\text{cm}$ contains units that are well known in the art and the above explanation shows how such units are obtained for the ratio.

Applicants respectfully request withdrawal of the rejection of claims 1-3 under 35 U.S.C. § 112, second paragraph.

Claims 1-11 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. 3,642,584 to Quinn et al. Applicants respectfully traverse this rejection.

Since claim 7 was canceled, the rejection with respect to claim 7 is moot.

The Office Action has not presented a *prima facie* case of obviousness. The applied document does not teach or suggest a resin composite material in which a component comprising

a metal, metal alloy, metal compound or mixtures thereof is present at a surface of a resin base, said non-charging resin composite material having a ratio of a surface resistance of said resin composite material to a resistivity of said component containing metal element is 10^{12} to 10^{17} ($1/\square\cdot\text{cm}$) as recited in claim 1. The applied document also does not teach or suggest the method recited in amended claim 6. Quinn et al. do not teach or suggest all of the elements of claims 1 and 6. See In re Wilson, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Quinn et al. is totally silent on the ratio of surface resistance of the resin composite material to the resistivity of the component containing the metal, metal alloy, or metal compound as recited in present claims 1 and 6.

The Office Action at page 3, paragraph 2 alleges that "...it would have been obvious to one of ordinary skill in the art to select the metal element and to vary the amount of metal element deposited on the substrate in order to obtain the desired level of conductivity. The examiner takes the position that one would necessarily change the 'ratio of the resin composite material to the resistivity of said component containing metal element' with the selection of the metal element and by varying the amount of metal element deposited." However, Quinn et al. would not have provided any reason or motivation to form a resin composite material having the recited ratios of claims 1 and 6. As mentioned above, Quinn et al. are totally silent on such ratios. Obviousness can not be predicted on what is unknown. In re Spormann, 150 U.S.P.Q. 449, 452 (C.C.P.A. 1966).

Further, Quinn et al. do not address the same problems as the present invention. A resin composite material having a ratio of a surface resistance of the resin composite material to a resistivity of the component containing the metal, metal alloy or metal compound of 10^{12} to 10^{17} ($1/\square\cdot\text{cm}$) prevents damage to the resin base from electrostatic electricity caused by charging and can prevent adhesion of dust and dirt particles to the resin composite material (substitute specification, page 24, lines 5-7).

In contrast, Quinn et al. are directed to a method of metal plating plastics and articles having adherent metal coatings that are resistant to peeling, temperature cycling, corrosion, and electrically conductive as well as metal coatings to protect articles from abrasion, scratching, and marring, reduce their porosity and improve their thermal conductivity (Quinn et al. col. 1, lines 19-29). No where does Quinn et al. address the problems which the presently claimed invention addresses. Accordingly, a person of skill in the art would not have had any reason or motivation

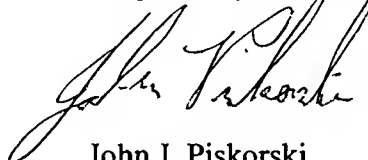
to make the resin composite material of the presently claimed invention in view of Quinn et al. It is only by reading Applicants' specification that a person of skill in the art would have been motivated to make Applicants' invention. Using Applicants' disclosure in an obviousness rejection is improper.

Applicants respectfully request withdrawal of the rejection of claims 16 and 8-11 under 35 U.S.C. § 103(a) over U.S. 3,642,584 to Quinn et al.

Favorable consideration and allowance of claims 1-6 and 8-13 are earnestly solicited.

If the Examiner has any questions concerning this response or this application, or if he believes this application is for any reason not yet in condition for allowance, he is respectfully requested to telephone the undersigned at the number set forth below in order to expedite allowance of this application.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "John J. Piskorski".

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